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Application No.	: 10/699,485	
Filing Date	: October 30, 2003	

Appellant	:	Vernon, et al.
App. No	:	10/699,485
Filed	:	October 30, 2003
For	:	MAGNETIC RAKE
Examiner	:	Terrell Howard Matthews
Art Unit	:	3654

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Nira Brand

Nira Brand, Reg. No. 52,648

ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed on August 13, 2007, Appellants submit this Reply Brief and hereby request that that the Appeal be maintained.

Appellants' arguments responding to the Examiner's new explanation of the rejections are included here and are intended to supplement, rather than to replace, the Arguments section of the Second Amended Appeal Brief filed on February 7, 2007. In addition, an updated version of the Claims Appendix is included herein to correct a typographical error pointed out by the Examiner.

The remaining sections of the Appeal Brief, namely, the Real Party in Interest, Related Appeals and Interferences, Status of Claims, Status of Amendments, Summary of Claimed Subject Matter, Ground of Rejection to be Reviewed on Appeal, Preliminary Amendment Appendix, Evidence Appendix, and Related Proceedings Appendix remain as presented in the second Amended Appeal Brief filed February 7, 2007.

Additional Arguments begin on page 2 of this paper.

Claims Appendix begins on page 7 of this paper.

ADDITIONAL ARGUMENTS

The primary reference relied upon by the Examiner for the 103(a) rejections of Claims 4, 6-9, and 13-19 is U.S. Patent 5,395,148 to Jameson. As depicted in FIGURE 1, reproduced below, Jameson provides a device with a smooth, streamlined body 20, typically made of plastic, for enclosing magnets 60. The device may be passed across the ground to magnetically attract and pick up metallic particles off the ground.

In addition, as depicted in FIGURE 2, Jameson further provides a close-fitting cleaning cuff 100 that may be slid onto and over the surface of the device body 20 to push off the metallic particles that have collected on the body (See FIGURE 4). A slit 102 in the cuff allows the motion of the cuff to proceed unobstructed by the handle 50. When not in use, the cleaning cuff 100 is depicted as being stored on the handle 50 of the device (See FIGURE 1).

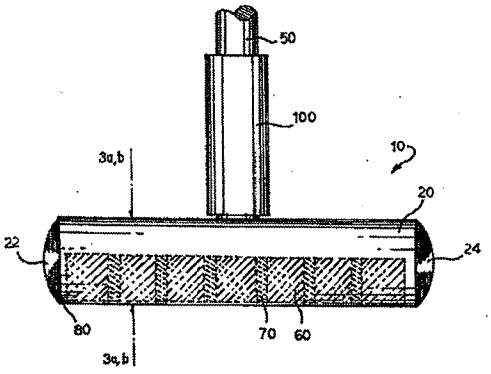


Figure 1
Jameson et al.

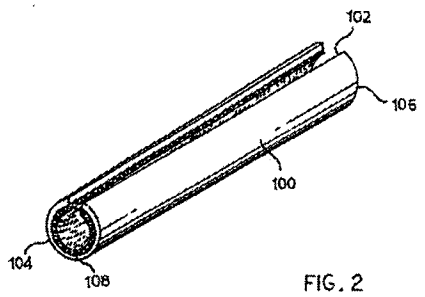


FIG. 2

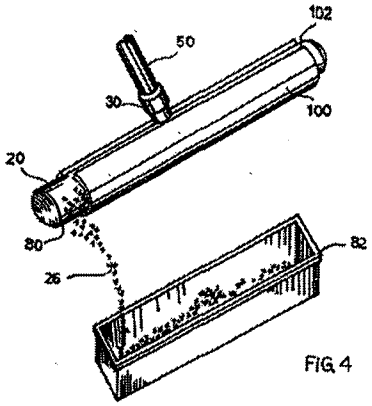
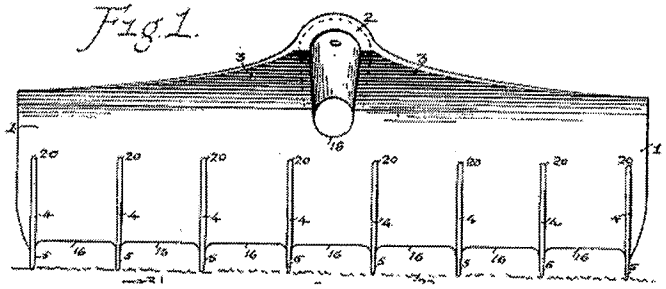


FIG. 4

The secondary reference for the 103(a) rejections is U.S. Patent 1,927,873 to Lantz. Lantz provides a leaf rake, which he calls a NON-LEAF HOLDING RAKE, whose very unusually shaped teeth, or tines, are specifically designed for raking leaves *without* allowing the leaves to adhere to the rake. Depicted below are three views of the Lantz's special rake tines, which look very different from each vantage point.



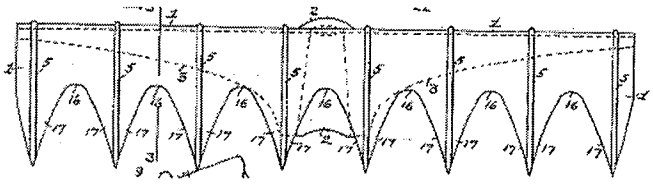
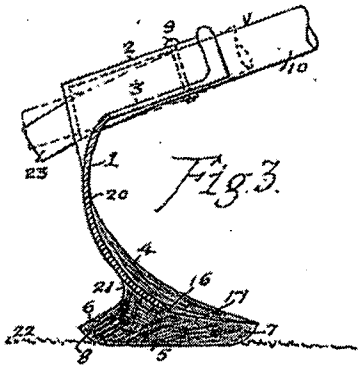


Figure 2



Lantz describes the teeth of his leaf rake as: "...pointed teeth that curve upwardly and forwardly in front of the curved rake body and extend rearwardly beneath the body forming short teeth on its rear surface." He also states that "the ribs 4...simulate ordinary rake teeth but they are formed as curved ribs integral with the body." Lantz goes on to describe the how his device keeps leaves from adhering to the rake:

> The leaves which are gathered in front of the rake roll upward without adhering to the body because the projecting ribs 4 prevent this, and small leaves will not pass through beneath the body, but the grass can freely pass between the shoes 5 and beneath the edge 16.

In the Examiner's previous explanations of the 103(a) rejections, he stated that:

> It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the apparatus of Jameson to include an aluminum toothed body as taught by Lantz so that the teeth could agitate and pull up particles from the ground.

It is unclear whether the specially designed teeth/ribs of Lantz in combination with Jameson's device would, in fact, agitate and pull up particles from the ground, as taught by the Appellants (See paragraph [0011]).

Furthermore, Appellants' arguments presented in the Second Amended Appeal Brief filed on February 7, 2007 explain why modifying Jameson to include the toothed rake body of Lantz would render a device that would no longer be suitable for its stated purpose. In particular, the magnetic device of Jameson would no longer have a cylindrical or otherwise streamlined body, allowing a close-fitting cleaning cuff to be passed over and to push off the metallic particles that have collected on the body.

In the Examiner's Answer to the Appeal Brief, the Examiner now explains a new way to combine Jameson and Lantz, stating that:

> It should further be noted that [it] is generally known in the art to provide teeth, tines, or prongs on sheaths or cuffs and that it would have only required routine skill in the art to modify the cuff of Jameson to include teeth, tines, or prongs.

However, this rationale for the obviousness rejections is also flawed. For several reasons, to be described below, adding teeth or tines to the *cuff* of Jameson would again render a resulting device that is unsuitable for its intended purpose.

Firstly, the operability of the Examiner's combination relies on a basic assumption that Jameson's device would still work to collect metallic particles, even with the cleaning cuff installed over the device body. In other words, the cuff would need to allow the magnetism from the magnets within the device body to pass through it with sufficient force to attract and hold the particles to the cuff. However, there is no way that we can know if the Examiner's assumption is true. Jameson does not disclose

anything about the material composition or the thickness of the cleaning cuff, other than to say that it includes a felt-like underlining 108 that allows it to slide smoothly over the body of the device. The Examiner attempts to rely on the Doctrine of Inherency. However, it has long been established, as cited in MPEP 2112(IV), that:

> To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson,* 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 19999) (citations omitted)

Without the assumed ability of the device to attract and hold the metallic particles to the cuff when installed on the body of the device, leaving the cuff *on* the Jameson device during use would cause the device to totally fail to operate for its intended purpose of colleting metallic particles.

Furthermore, Jameson's cuff is used only to clean debris *off* of the body of his device, rather than to assist in collecting the debris from the ground. (See Jameson, col. 3, line 29). If anything, the cuff's description and intended purpose of pushing the particles *off* of the device body would more likely lead a person of ordinary skill to assume that the cuff should *not* allow the magnetism to pass through, so that the particles are not attracted to the cuff, clumping up around it as it attempts to push the particles off the device.

Secondly, adding Lantz's teeth to the cuff of Jameson and then using the cuff solely for cleaning, as taught by Jameson, would in no way agitate the earth or help dislodge metallic items from the ground, as intended by Appellants' device. Furthermore, storing the toothed cuff on the device handle (while the device *is* being used to collect metallic particles), could prove unwieldy or even dangerous to the operator of the device.

Even if the toothed cuff *were* left on the body of the device during use, and even assuming that the magnetic attraction of the magnets was strong enough to attract metallic particles to the cuff, the teeth, when attached to the cuff, would not possess

sufficient rigidity to effectively agitate the hardened soil, such as at a construction site, in which nails, screws, and the like may be impacted. The intentionally open sides 204, 106 of Jameson's cuff would deprive the teeth of lateral rigidity. Additionally, the openness of the slit 102, which allows the cuff to slide back and forth across the body, unobstructed by the handle, would diminish the fore and aft rigidity of the teeth, while placing extra stress upon the teeth themselves.

Additionally, as explained previously, the specially designed tines of Lantz's Non-Leaf Holding Rake would prove especially unsuitable for the intended use of Appellant's device and would not likely be considered a good choice by one of ordinary skill in the art in attempting to invent an improved magnetic rake.

Although combining references is an important aspect of determining obviousness in a patent examination, as the Examiner himself points out on page 6 of his Answer, "There must be some reason why one skilled in the art would be motivated to make the proposed combination of the primary and secondary references." Furthermore, this reason, to be proper, must not be supplied by hindsight alone. Jameson was undoubtedly familiar with rakes, and, indeed, even (improperly) used the term "rake" for his un-toothed device. But neither he nor others of skill in the art, neither at the time of the invention nor in the decade to follow, have invented a magnetic rake with a toothed, unitarily formed, hollow rake body until the Appellants' invention of the device being considered in this Appeal.

CONCLUSION

For the reasons given above, Appellants respectfully submit that the combination of Jameson and Lantz in order to establish the obviousness of Claims 4, 6-9, and 13-19 is improper. Appellants further submit that the pending claims of this application are allowable and respectfully request that the rejections should be overruled by the Board of Appeals.

Respectfully submitted,

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CLAIMS APPENDIX

The following is a listing of the claims being appealed:

4. A magnetic rake, comprising:
one or more magnets;
a hollow, unitarily formed, toothed rake body containing said magnets; and
a handle attached to said rake body.

6. The magnetic rake of Claim 4, wherein said hollow, unitarily formed toothed rake body is formed of a non-magnetic alloy.

7. The magnetic rake of Claim 6, wherein said non-magnetic alloy is aluminum.

8. The magnetic rake of Claim 4, wherein said handle is detachably connected to said hollow, unitarily formed toothed rake body using a mechanical system.

9. The magnetic rake of Claim 4, wherein said handle is permanently attached to said hollow, unitarily formed toothed rake body.

13. A method of collecting ferro-magnetic items from a surface area, said method comprising the acts of:
operating over said surface area a hollow, unitarily formed toothed rake body that contains at least one magnet inside; and
allowing ferro-magnetic items from said surface area to collect on said rake body.

14. The method of Claim 13, wherein operating said hollow, unitarily formed toothed rake body comprises agitating said surface area with said teeth to loosen said ferro-magnetic items.

15. The method of Claim 13, wherein operating said hollow, unitarily formed toothed rake body comprises inverting said rake body such that a toothed portion of said hollow, unitarily formed toothed rake body faces away from said surface area.

16. A system for collecting ferro-metallic items from an area, said system comprising:
means for agitating a ground surface of said area; and

means, enclosed within said means for agitating, for attracting ferro-metallic items to said means for agitating using magnetic force.

17. The system of Claim 16, wherein said agitating means comprise hollow, unitarily formed toothed rake body with triangular teeth.

18. The system of Claim 16, wherein said agitating means comprise a hollow, unitarily formed toothed rake body with non-triangular teeth.

19. The system of Claim 16, wherein said attracting means comprise magnets housed inside a hollow, unitarily formed toothed rake body.

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